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09/974,646

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William L. Thomas

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ROPES & GRAY LLP
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EXAMINER

LONSBERRY, HUNTER B

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

12/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/974,646

Applicant(s)

THOMAS ET AL.

Examiner

Hunter B. Lonsberry

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-23, 25-33 and 56-116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-23, 25-33 and 56-116 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

The examiner relies upon newly cited US 5,884,141 to Inoue to teach recording the media on demand program. The Examiner further notes that the claims in their current form merely require a freeze and recording of the on demand program, the program which is recorded need not be the portion which is played back, rather a bookmarked portion may be played back. Applicant's specification appears on pages 24-25 to support both a bookmark type feature as well as playing back the recorded stream from the point in which it was paused.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-11, 16-23, 25-28, 33, 57-68, 71-83 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al (USPN 6,166,730) in view of U.S. 5,884,141 to Inoue.

Regarding claims 1, 3, 5, 6, 17, 18, 20, 22 and 23, Goode discloses a video on demand system in which a user can pause a video program from one set-top box and resume the video from another set-top box per a user request from the point at which the program was paused.

Goode discloses providing multimedia programming including audio, video, graphics and like on an on-demand basis (see col. 2, line 64 - col. 3, line 5). A video session manager (VSM) 106 (Fig. 1) located upstream from the user manages an on-demand session by receiving commands from the user, including pause, for interrupting the transmitted stream (see col. 5, lines 30-45). Once a user indicates a desire to pause a program, the pause command is transmitted to the VSM to interrupt transmission of the program stream. The VSM bookmarks the location of the pause or freeze command (see col. 19, lines 5-42). In addition to, regarding the claimed, "configured to record the media-on-demand program when the request to freeze delivery is received from the first user equipment" (see claim 1), or in a similar manner, the claimed, "recording the media-on-demand program on a remote media-on-demand server when the request to freeze delivery is received from the first user equipment" (see claim 18), the Goode reference further meets these claimed limitations as described above in col. 19, lines 5-42, where when the first user selects a stop or pause on the remote control the program is recorded or stored in the video server and may be accessed through the menu selection "Active Programs/Saved Movies" that list previously stored movies. A user can resume playing of the on-demand session from the paused location on another set-top by sending a command to the VSM to resume playing of the on-demand session (see

col. 19, lines 5-42), the bookmarked position is retrieved, and playing of the on-demand program is resumed. Furthermore, as described in col. 19, lines 5-42 of Goode et al the user has the option of relocating to another set top box and freezing or stopping the delivery of the media- on-demand program while relocating from one set top box to another or second set top box.

Goode however fails to record the media on demand program when the request to freeze delivery is received from the first user equipment.

Inoue discloses a NVOD signal receiver in figure 1, with a tuner 101, microcomputer 109 and buffer memory apparatus 12 (column 3, line 53-65, column 4, line 57-column 5, line 20). A use may freeze delivery of a program by pausing the NVOD (figures 2a/b, column 5, line 61-column 6, line 52, column 12, line 53-column 13, line 3), thereby extending viewing options by enabling a user to watch NVOD programs.

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to modify Goode to include the pausing and NVOD features as taught by Inoue for the advantages of providing a user with additional programming choices through NVOD, saving bandwidth through the user of NVOD and enabling a user to pause an NVOD program thereby providing more flexibility to the user's viewing choices.

Regarding claims 2, 16, 19 and 33, Goode discloses the paused position is bookmarked in a memory location specific to the user (see col. 19, lines 18-43). Necessarily, the remote on demand server is configured to save the point at which the

media-on demand program was frozen (user specific data) to the user-specific storage space on the remote media-on-demand server. It is further noted that a plurality of user's can use the system thus remote media-on demand server includes user-allocated storage space portioned for different users to store user- specific data.

Regarding claims 4 and 21, Goode discloses providing/displaying a title screen menu for selecting a previously paused program to resume the program by requesting and transmitting a resume command to the VSM (see col. 19, lines 18-38).

Regarding claim 8, Goode discloses that the media-demand presentation is resumed on the second user equipment when the remote media-on-delivery server retrieves the beginning of the recorded media-on-demand program and plays the media-on-demand program from the beginning of the media-n-demand program on the second user equipment (see col. 19, lines 18- 42).

Regarding claims 9, 26, 27 and 56, Goode discloses a user can input a PIN or personal identification information and log in to the system (see col. 5, lines 10-15, also see col. 19, lines 5-42).

Regarding claims 10, 11 and 28, Goode discloses a user inputs a PIN to start an on- demand session (see col. 5, lines 10-15). Once a user is logged in to a session, the user can freeze or pause the delivery of the on-demand stream and resume delivery from another set-top (see col. 19, lines 18-43).

Regarding claim 25, Goode discloses a user can pause or stop a program from a first set-top, make a payment and view the same program from a second set-top from the beginning (see col. 17, lines 32-55) and thus discloses the claimed limitation.

Regarding claim 57, the claim is rejected based on the rejection of claims 1 and 3.

Regarding claims 58-68 and 71-72, the claims are rejected based on the rejection of claims 2, 4-6, 1, 8-11 and 16-17, respectively.

Regarding claim 73, the claim is rejected based on the rejection of claims 18 and 20.

Regarding claims 74-83 and 88, the claims are rejected based on the rejection of claims 19, 21-23, 18, 25, 56, 26-28 and 33, respectively.

Claims 12-13, 29-30, 67-68 and 84-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al (USPN 6,166,730) in view of U.S. 5,884,141 to Inoue in further view of Ludwig et al (USPN 6,816,904).

Regarding claims 12-13, 29-30, 67-68 and 84-85, Goode discloses an login option (PIN) but fails to disclose the claimed providing the user with an opportunity to log out of the system from the first user equipment and providing the user with an

opportunity to log out comprises displaying an display screen that includes a logout option.

Ludwig et al teaches a video-on- demand system, which includes the use of "login" and "logout" security features (see col. 20, line 63 - col. 21, line 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modified combination of Goode and Inoue references with the additional teachings of the Ludwig et al reference, which includes a feature for logging out of a session for the advantage of providing a more secure system by ensuring others cannot access a user's session. One of ordinary skill in the art would have been led to include the claimed limitations for the benefit or ensuring others do not access a users on-demand session thereby providing a more secure system.

Claims 14, 31, 69, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al (USPN 6,166,730) U.S. 5,884,141 to Inoue, in further view of Sull et al (US 2002/0069218).

Regarding claims 14, 31, 69 and 86, Goode discloses a media on-demand server, but fails to disclose providing the user with an opportunity to request to freeze delivery in response to the logout option being selected.

Sull et al teaches a video-on-demand system where a subscriber can stop or freeze a delivery in response to a log out option being selected (see ¶ [0013]).

Therefore, it would have been obvious to one of ordinary skill in the art to have modified the teachings of the combination of Goode and Inoue with the additional teachings of Sull, which discloses a video-on-demand system where a subscriber can request to freeze delivery in response to the logout option being selected, for the advantage of enabling a user to return directly to the point a media program was frozen or stopped due to logging out of the system without having to go through a time-consuming playback of the multimedia file from the beginning. One of ordinary skill in the art would have been led to make such a modification for the benefit described above.

Claims 15, 32, 70 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al (USPN 6,166,730), U.S. 5,884,141 to Inoue, in further view of Abecassis (USPN 5,610,653).

Regarding claims 15, 32, 70 and 87, Goode discloses a media on-demand server, but fails to disclose uploading a user's personal media from the first user equipment to the remote media- on demand server. Abecassis teaches a video-on-demand system where a subscriber can both upload and download video (see col. 34, lines 36-41).

Therefore, it would have been obvious to one of ordinary skill in the art to have modified the teachings of the Goode and Inoue references with the additional teachings of Abecassis, which discloses a video-on-demand system where a subscriber can both

upload and download video, for the advantage of enabling other users or subscribers to access the personal media per request. One of ordinary skill in the art would have been led to make such a modification for the benefit of sharing a user's personal media with others interested in accessing or viewing the personal media.

Claims 89-99 and 101-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al (USPN 6,166,730), U.S. 5,884,141 to Inoue in further view of Ludwig et al (USPN 6,816,904), in further view of Sull et al (US 2002/0069218).

Regarding claim 89, the claim is rejected based on the rejection of claims 1, 12-13 and 14 as described above.

Regarding claims 90-99 and 101-102, the claims are rejected based on the rejection of claims 2-6, 1, 8-11 and 16-17, respectively.

Regarding claim 103, the claim is rejected based on the rejection of claims 18, 29-30 and 31 as described above.

Regarding claims 104-114 and 116, the claims are rejected based on the rejection of claims 19-23, 18, 25, 56, 26-28 and 33, respectively.

Claims 100 and 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al (USPN 6,166,730), U.S. 5,884,141 to Inoue in further view of Ludwig et al (USPN 6,816,904), in further view of Sull et al (US 2002/0069218), in further view of Abecassis (USPN 5,610,653).

Regarding claim 100, the claim is rejected based on the rejection of claims 89 and 15, as described above.

Regarding claim 115, the claim is rejected based on the rejection of claims 103 and 32, as described above.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Hunter B. Lonsberry
Primary Examiner
Art Unit 2623

HBL